

Application No.: 09/825,604

Docket No.: 13CN-126433

REMARKS

The Examiner rejected claims 73 – 82 and 84 under 35 U.S.C. § 101 as allegedly being directed toward non-statutory subject matter. The Examiner further rejected claims 25, 73-81 and 84 under 35 U.S.C. § 102(e), and claims 82 – 83 under 35 U.S.C. § 103 as allegedly being unpatentable over the cited references.

In view of the below remarks, Applicants believe the claims are in condition for allowance and reconsideration is respectfully requested. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

Summary of Amendments

Applicants have amended claim 25 to replace "at least one" with "a" as the claim is written with the open-ended term comprising, and the phrase "at least one" is not required to allow for more than one.

Claim 73 is amended to include a step of assigning the insurance claim to the assignee. Claim 74 was amended to clarify that the difference in effect given to the elements is a weighting. Because assignment of a claim and weighting were previously presented in other pending claims, these amendments do not necessitate a further search.

Claims 76, 78 and 80 are amended to clarify that the recited feature is not necessarily limited to only one element of the group.

Applicants have canceled claim 83.

Claim 84 is amended to recite that the modules are embodied in or on a computer readable medium.

Applicants have added claims 85 – 93, which depend from independent claim 84. These new claims contain limitations similar to those previously considered by the Examiner in other currently pending claims. As such, these amendments do not necessitate a further search.

These amendments do not contain new matter and do not raise any issues that would require further consideration or search beyond what was previously presented. As such, their entry is respectfully requested.

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Rejections under 35 U.S.C. § 101.

The Examiner rejected claims 73 – 82 and 84 under 35 U.S.C. § 101. Applicants believe that determining an assignee type is a practical result and further that the method recited in the claim results in a physical transformation. Nonetheless, to expedite prosecution Applicants have amended claim 73 to include a step of assigning the insurance claim to an assignee. As such, Claim 73, along with claims 74 – 82, which depend therefrom, should be in immediate condition to overcome this rejection. Applicants respectfully request that the Examiner withdraw the rejection of claims 73 – 82 under 35 U.S.C. § 101.

With respect to claim 84, applicants have amended the claim, such that the elements are embodied in or on a computer readable medium. As such, claim 84 is now drawn to statutory subject matter, and Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 101.

Rejections under 35 U.S.C. §§ 102 and 103.

The Examiner rejected claims 25, 73-81 and 84 under 35 U.S.C. § 102(e), and claims 82 – 83 under 35 U.S.C. § 103 as allegedly being unpatentable over the cited references.

Claim 25

Borghesi fails to teach determining a *type* of assignee for the claim. All that Borghesi teaches is that if the user desires a custom total valuation, the user can request a valuation from a third party database provider (13:20-22, and 13:50-52). Nowhere does Borghesi teach or suggest determining a *type* of assignee based on the score and class of the claim. Moreover, Borghesi does not teach or suggest determining an assignee type based on an application of business rules to the score and class of the insurance claim, where class is weighted more highly than score. All that Borghesi teaches is checking to see if the total cost is approaching a threshold total value, and that a user can request a specific valuation from a third party provider if the user desires.

Taking the Examiner's allegations of Borghesi's teachings at face value, claim score would be taught by Borghesi's teaching of repair cost; class would be taught by user entry of a vehicle type, and determining a type of assignee would be taught by transferring a valuation

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request to a third party valuation service. For these to meet the claim language, a type of assignee would have to be chosen based on repair cost and vehicle type, weighing vehicle type more than repair cost. Yet, Borghesi does not teach choosing a valuation service based on cost and vehicle type (let alone choosing a *type* of assignee). Moreover, there is absolutely no discussion in Borghesi of weighting either of these factors in calling a valuation service.

For at least these reasons, Applicants submit that claim 25, is patentably distinct over Borghesi, and respectfully request that it be passed to allowance.

Additionally, The Examiner alleges that the Borghesi teachings at Col. 13 lines 14-18 of prompting the user that the total cost of repairing a vehicle is approaching a threshold teach the recited step of determining a *priority* of the insurance claim. Applicants respectfully submit that comparing an estimate cost with a threshold total value does not teach or suggest determining a *priority* of the claim.

For at least this additional reason, Applicants submit that claim 25, is patentably distinct over Borghesi, and respectfully request that it be passed to allowance.

Claims 73, 74, 76, 77, 79, 81 and 84

The Examiner rejected claims 73, 74, 76, 77, 79, 81 and 84 under the same grounds as alleged in Claim 25. Thus, for the reasons set forth above, Applicants respectfully submit that these Claims and all the claims that depend therefrom are patentably distinct over Borghesi, and Applicants respectfully request that they be passed to allowance.

Additionally Claim 76 recites that the score is determined based on information regarding an insurance policy, a party involved in a loss, or how a loss was reported. Yet, the Examiner alleges that score is tied to a repair cost value. This is remarkably different from information regarding an insurance policy, a party involved in a loss, or how a loss was reported. For this additional reason, Claim 76 is patentably distinct over Borghesi, and Applicants respectfully request that it be passed to allowance.

Claims 82 and 83

The alleged combination set forth by the examiner, even if properly made, fails to teach the claimed invention. Claim 82 recites that "each profile in the second set includes a measure of *capacity* to complete the insurance claim; and determining, from the second set of profiles, a profile with the largest measure of *capacity*."

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The Examiner alleges that Brooks teaches this at 11:6-19, and 39 – 47. However, these teachings do not provide the missing teachings of Borghesi. Instead, Brooks teaches ranking repair shops by discount, satisfaction, and last repair service performed, and that shops are arranged in rotation based on their last service date. This does not teach or suggest a measure of capacity, nor does it teach or suggest determining a profile with the largest measure of capacity.

Also, per the Examiner, the Assignee in Borghesi is a valuation service provider. Such providers typically do not conform to the metrics listed by Brooks such as ranking repair shops by discount, satisfaction, and last repair service performed. These are classic repair shop rankings. As such, one would not know to look to Brooks to apply these criteria to a valuation service. Additionally, Borghesi teaches away from profiling service providers. Borghesi simply teaches that a user can contact a valuation service, and saving time by automatically transferring files to the valuation service. This teaches away from a more complex system of ranking service providers.

For these reasons, Claims 82 and 83 are patentably distinct over the combination, and Applicants respectfully request that they be passed to allowance.

Claims 85 – 93

New claims 85 – 93 include recitations similar to those discussed above. As such, for the reasons set forth above, new Claims 85 – 93 are also patentably distinct from the cited references and should be passed to allowance.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time

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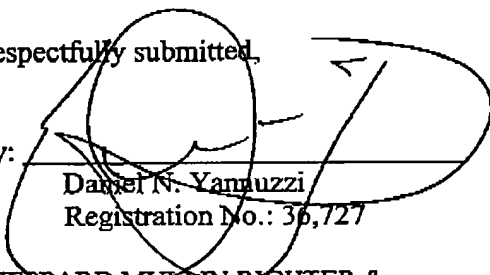
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and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 18-1953 referencing Docket No. 13CN-126433. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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